



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,005	12/08/2003	Toshiyasu Shirasuna	03500.015546.1	9109

5514 7590 04/04/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

CROWELL, ANNA M

ART UNIT PAPER NUMBER

1763

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,005

Applicant(s)

SHIRASUNA ET AL.

Examiner

Michelle Crowell

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 12-13 are pending in the application. Claims 12-13 are rejected.

1. Claim 12 is objected to because of the following informalities: On page 3, line 2, the word “**moveable**” is misspelled. The correct spelling is **movable**. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation, “one impedance regulation means is provided between a connecting portion of the high-frequency power supply means on the side of the moveable reactor and an electrode on the side of the moveable reactor” which is indefinite. It is unclear how the connecting portion and the electrode are located on the side of the moveable reactor. The suggested claim language is as follows: “one impedance regulation means is provided between a connecting portion of the high-frequency power supply means **which is on the outside** of the moveable reactor and an electrode **which is on the inside** of the moveable reactor”. For

Art Unit: 1763

purposes of examination, the connecting portion is located on the outside of the moveable reactor and the electrode is located on the inside of the moveable reactor.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamura et al. (Japanese Patent Publication 11-319546) in view of Turlot et al. (U.S. 5,515,986).

Referring to Drawing 1, the abstract, and paragraph [0007], Okamura discloses a plasma treatment apparatus comprising a plurality of movable reactors 1100 each an evacuable inside where at least one treatment substrate 1107 is set in; a high frequency power means 1111 for supplying high-frequency power into each movable reactor having been inside-evacuated, to cause glow discharge to take place in the movable reactor; an impedance regulation means 1110

Art Unit: 1763

provided on the side of a movable reactor in order to regulate the impedances of each reactor; and a moving means 1104 for moving the reactors, wherein each of the movable reactors and the high-frequency power supply means are provided separably and wherein one impedance regulation means is provided between a connecting portion of the high-frequency power supply means on the side of the moveable reactor and an electrode on the side of the moveable reactor.

Okamura et al. fail to teach an impedance regulation means provided on the side of each reactor.

Referring to Figures 2a-2d, 5c, column 3, line 60 –column 4, line 20, and column 6, line 62–column 7, line 21, Turlot et al. teaches a plasma treatment apparatus having an impedance regulation means (inductors in Fig. 5c) provided on the side of each reactor 20. By using an impedance regulation means for each reactor, the process conditions may be adjusted for each reactor (col. 7, lines 2-9). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide each reactor of Okamura et al. with an impedance regulation means as taught by Turlot et al. in order to adjust the process conditions for each reactor.

With respect to claim 13, Okamura et al. discloses that the substrate is an electrophotographic photosensitive member (abstract and par.[0007]). Additionally, it should be noted that the type of substrate (i.e. electrophotographic photosensitive member) used in apparatus claims is not given patentable weight (In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963))).

Response to Arguments

7. Applicant's arguments filed January 23, 2005 have been fully considered but they are not persuasive.

Applicant has argued that Turlot fails to teach that only one reactor is connected to one power supply means as shown in Figure 8; however, the elected species is Figure 5, and according to page 22 of the specification, only one high-frequency power supply means is used for many reactors. Thus, the apparatus of Okamura et al. in view of Turlot et al. satisfies the claimed requirement.

Applicant has argued that the applicant's invention includes only a single impedance regulation means for each reactor and that Turlot teaches an impedance regulation means for each electrode; however, as seen in Figure 5(c) and column 7, lines 7-9, one impedance regulation means is assigned to each reactor (not each electrode). Thus, the apparatus of Okamura et al. in view of Turlot et al. satisfies the claimed requirement.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1763

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Crowell whose telephone number is (571) 272-1432. The examiner can normally be reached on M-F (9:30 -6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on (571) 272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michelle Crowell *me*
Patent Examiner
Art Unit 1763

pt
Parviz Hassanzadeh
Supervisory Patent Examiner
Art Unit 1763